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**DEC 29 2004**

**OFFICE OF PETITIONS**

In re Application of :  
Coombs, et al. :  
Application No. 10/792,291 : DECISION REFUSING STATUS  
Filed: March 2, 2004 : UNDER 37 CFR § 1.47(a)  
Attorney Docket No. NAGACO.074A :  
For: METHODS AND APPARATUS FOR USE :  
IN DETECTION AND QUANTIFICATION OF :  
VARIOUS CELL TYPES AND USE OF OPTICAL :  
BIO-DISK FOR PERFORMING SAME :

This is a decision on the petition styled "Petition To File Declarations on Behalf of Nonsigning Inventors Who Refuse to Sign or Cannot be Reached Under 37 CFR 1.47(a)," filed October 25, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. § 1.136(a).

The above-identified application was filed on March 2, 2004, without an executed oath or declaration and missing the statutory basic filing fee. Accordingly, on May 25, 2004, applicants were mailed a "Notice to File Missing Parts of Nonprovisional Application," requiring submission of an executed oath or declaration, payment of the filing fee, additional claim fees and payment of the surcharge for late filing under § 1.16(e).

In response, rule 47 applicants filed the instant petition, along with payment of the petition fee, the basic filing fee, additional claim fees and the late surcharge. This response was made timely

by an accompanying petition (and fee) for extension of time within the third month. On petition, applicants assert that status under § 1.47(a) is proper because inventors Gordon and Urcia refuse to join in the application. In support thereof, applicant submits a statement of facts by patent attorney Russell Jeide.

A grantable petition under 37 C.F.R. § 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirement (2).

Pursuant to 35 U.S.C. 115 and 37 CFR § 1.63(a) and § 1.63(c)(1), an acceptable oath or declaration filed under § 1.51(b)(2) as a part of a nonprovisional application must identify all the inventors by name, citizenship and, unless such information is supplied on an application data sheet (ADS) in accordance with § 1.76, must also identify the mailing address, and the residence of each inventor, if an inventor lives at a location which is different from where the inventor customarily receives mail.

Petitioner has shown that the non-signing inventors Gordon and Urcia have refused to join in the filing of the above-identified application after having been presented with the application papers. The petition includes payment of the petition fee and includes a statement of the last known address of non-signing inventors Gordon and Urcia. However, the petition does not include an acceptable declaration.

The Office received a two-page declaration on October 25, 2004, identifying James H. Coombs, John F. Gordon and Brigitte C. Phan as the joint inventors. The declaration does not identify Joseph R.I. Urcia as one of the joint inventors. The petition cannot be granted until an acceptable declaration in compliance with §§ 1.63(a) and 1.63(c)(1) is filed.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                   Mail Stop PETITION  
                              Commissioner for Patents  
                              Post Office Box 1450  
                              Alexandria, VA 22313-1450

By hand:                 U.S. Patent and Trademark Office  
                              220 20<sup>th</sup> Street S.  
                              Customer Window, Mail Stop PETITION  
                              Crystal Plaza Two, Lobby, Room 1B03  
                              Arlington, VA 22202

The centralized facsimile number is (703) 872-9306.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3204.

A handwritten signature in cursive script, reading "Sherry D. Brinkley". The signature is written in black ink and is positioned above the printed name and title.

Sherry D. Brinkley  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy